

- - Remarks - -

Claims 1-29 remain in the case. Claims 1-10, 12-22, 24-27, have been currently amended to point out more particularly Applicant's invention, without addition of new matter.

None of the references, taken singly or in combination, discloses or suggests Applicant's invention, nor is there any evidence of obviousness of any of the currently amended claims. The PTO has wholly failed to discharge its burden of proof of alleged obviousness of the amended claims. As shown hereinbelow, substantive evidence is adduced of nonobviousness per the "Secondary Considerations" of *Graham v. John Deere*.

I. REJECTION OF AMENDED CLAIMS 1-11, 13-23, and 25-29, FOR ALLEGED OBVIOUSNESS UNDER 35 USC 103 IS LEGALLY AND FACTUALLY ERRONEOUS AND SHOULD BE RECONSIDERED AND WITHDRAWN.

In formulating a rejection under 35 USC Sec. 103(a) based on a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. Memorandum to the Patent Examining Corps, responding to the *KSR* decision, Margaret A. Focarino, Deputy Commissioner for Patent Operations, quoted in Patent, Trademark, and Copyright Journal, vol. 74 #1828, page 380 (July 27, 2007).

"To determine whether there was an apparent reason to combine the known elements in the way a patent claims, it will often be necessary to look to the interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having

ordinary skill in the art. To facilitate review, this analysis should be made explicit.” KSR Int’l Co. v. Teleflex, Inc., #04-1350 (550 US ____; 127 S. Ct. 1727) (April 30, 2007), 82 USPQ 2d 1385 (74 PTCJ 5,5/4/07), at 14.

“First there must be some suggestion or motivation... to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP Sec. 2142.

In *KSR*, the Supreme Court cited with approval the *Graham v. John Deere* standard for making an obviousness determination whereby “secondary considerations such as commercial success, long felt but unsolved needs, failure of others, etc. might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *KSR*, at 2.

Under the foregoing governing authorities, the Office Action clearly has failed to discharge the PTO’s burden of identifying the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. Further, the Office Action has failed to take account of the “secondary considerations” which provide evidence of patentability as shown hereinbelow.

A. THE REJECTION OF AMENDED CLAIMS 1-11, 13-23, AND 25-29, UNDER 35 USC 103(a) AS BEING ALLEGEDLY UNPATENTABLE OVER MUNDAY (U.S. 4,653,782), IN VIEW OF LOCHRIDGE (U.S. 3,603,617) AND FURTHER IN VIEW OF O’CONNOR (U.S. 2,779,375) UTTERLY FAILS TO MEET THE REQUIREMENTS IMPOSED BY LAW FOR SUCH REJECTION TO BE VALID.

The Office Action erroneously states, "Munday discloses the claimed invention as set forth in Claims 1-29, except for the retention means, and further "Lochridge teaches a pipe coupling assembly with securing means that includes nuts, washers, and bolts... "Lochridge employ [sic.] washers (31,32) on each end of the bolts as is known in order to better distribute the load on each end of the bolts. Accordingly, it would have been obvious to one having normal skill in the art at the time the invention was made to modify Munday to employ an additional washer at the head end of the bolts, as taught by Lochridge in order to better distribute the load on each end of the bolts. Munday/Lochridge fail to teach that the washers are split lock washers, which act to effectively retain the bolts to the clamp-halves. O' Connor teaches such a washer (see fig. 4 and Col.2, lines 31-49); one that is used to temporarily retain bolts in an assembled relationship until they are finally joined in the finished product. O' Connor's split washer also permits lateral positioning of the washer on a bolt or screw. In view of O' Connor's teaching, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ split-lock washers in Munday/Lochridge in order to temporarily retain the clamping bolts in an assembled relationship with the clamp-halves, until they are finally joined, and to permit lateral positioning of the washers on the bolts." (Office Action, pages 2-3).

The above-described attempted hindsight reconstruction is legally and factually erroneous regarding the invention as defined by the amended claims. It continues to be the law that there is no suggestion to combine references if a reference teaches away from its combination with another source. See Tec Air Inc. v. Denso Manufacturing Michigan Inc., 192 F.3d 1353, 52 USPQ 2d1294 (Fed. Cir. 1999).

As quoted with approval in *Tec Air*, “a reference may be said to teach away when a person of ordinary skill would be discouraged from following the path set out in the reference, or would be led in a path divergent from the path that was taken by the applicant [or] if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant.” In re Gurley, 27 F.3d 551, 31 USPQ 2d 1131 (Fed. Cir. 1994).

The foregoing authorities squarely apply to render the attempted hindsight reconstruction of Applicant’s invention factually and legally invalid.

In all of the cited art, there can be found no reference to or suggestion of Applicant’s loose retention by resilient retention means of screws in screw holes prior to final fastening with a nut. In all of the references, the washers are used as stated in the Office Action “to distribute load more evenly” thus providing a more stable final securement. Further, in the O’Connor reference the washer sought to be analogized to the retention means of the present application, is rigid and provides for holding a screw in a screw hole rigidly and with a complicated arrangement whose nature is suggested by the name/title of the O’ Connor patent “Split washer having one helical margin and one planar margin adapted to be secured to threaded fastener.”

As disclosed in the O’Connor patent, a split-ring lock washer 20 has an annular flange 24 “integral with the washer body [which] projects radially inwardly from the inner margin of the washer body and overlies an outwardly swaged annular end portion 26

of the skirt 18 [which depends from the clamping face 16 of a nut member 12]." O' Connor, Col.1 lines 60-65.

As further stated in the O' Connor disclosure, "Thus, the skirt and the flange 24 cooperate to preclude axial disassembly of the nut and lock washer... "The washer body 22 is partially helically disposed so that it will provide a progressively increasing locking pressure as the unit is clamped against a work piece. More specifically, the outer peripheral margin 28 of the washer body is helically disposed in the manner shown, but at the same time it should be noted that the inner margin of the washer body is formed so that the flange 24 lies substantially in a single plane. This structure provides the washer body with high resistance to collapsing, or in other words, the washer body is very stiff, and when collapsed, will exert a relatively high pressure for locking the nut member against unauthorized retrograde movement." O' Connor, Col. 1 Lines 65-67; Col. 2, lines 1-13, 26-30. (Emphasis added).

Clearly, the "very stiff" washer of O' Connor bears no resemblance in structure or function to the resilient retention means of the subject application. Moreover, in the present invention, the resilient retention means has no function in the final secured assembly (Curran Declaration, para. 3), in contrast to the washers in the cited references, all of which perform a function in the final secured assembly.

B. THE REJECTION OF AMENDED CLAIMS 10, 21, 22, and 23 UNDER 35 USC 103(a) AS BEING ALLEGEDLY UNPATENTABLE OVER MUNDAY (U.S. 4,653,782), IN VIEW OF LOCHRIDGE (U.S. 3,603,617) AND FURTHER IN VIEW OF O' CONNOR (U.S.

2,779,375) UTTERLY FAILS TO MEET THE REQUIREMENTS IMPOSED BY LAW FOR SUCH REJECTION TO BE VALID.

Regarding amended claims 10 and 22, these claims are nonobvious per se as depending respectively from nonobvious amended claim 1 and amended claim 13. Moreover, it would make no sense whatsoever to change the depicted circular orifices in the reference washers to any shape at all except round in view of the fact that they must fit snugly on round screws. This is in contrast to the resilient retention means of Applicant's invention, which resiliently contacts screws in loose retention in screw holes prior to final securement and need not be shaped similarly to the cross section of the screws. Similar considerations apply to amended claims 11 and 23 as apply to render the rejection of Amended Claims 10 and 22 invalid.

C. THE REJECTION OF AMENDED CLAIMS 12 and 24 UNDER 35 USC 103(a) AS BEING ALLEGEDLY UNPATENTABLE OVER MUNDAY (U.S. 4,653,782), IN VIEW OF LOCHRIDGE (U.S. 3,603,617) AND FURTHER IN VIEW OF O'CONNOR (U.S. 2,779,375) AND FURTHER IN VIEW OF CROWTHER (U.S. 1,874,462) UTTERLY FAILS TO MEET THE REQUIREMENTS IMPOSED BY LAW FOR SUCH REJECTION TO BE VALID.

Regarding Claims 12 and 24, the rejection of these claims as amended as allegedly unpatentable over Munday, in view of Lochridge and O' Connor, and further in view of Krowther (U.S. 1,874,462), is invalid.

The attempted patchwork reconstruction of four (!) patents to reach the claims at issue, is suggestive of invalidity of the rejection on its face. Furthermore, there would be no basis in reason or fact to provide adhesion means for the washers in Munday, Lochridge, and O' Connor, for securing a lock washer against a bolthead, since in all of those situations, the washers fit snugly on the screw and are "very stiff". It would make sense only in Applicant's device to employ adhesive means for the loosely fitting retention means loosely holding a screw in a screw hole.

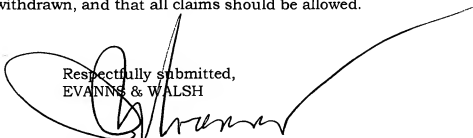
Accordingly, the Patent Office has utterly failed to discharge its burden of proof of unpatentability of the claims as amended and specifically, the burden of identifying the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. As a result, the rejection of the claims as amended is invalid, must be reconsidered and withdrawn, and the application should be allowed in its entirety. Memorandum to the Patent Examining Corps from Deputy Commissioner Focarino, *supra*.

In addition, as stated by the inventor John Curran in his supporting declaration filed concurrently herewith, the invention of the application fills a long-felt but unsolved need for a retention device for loosely holding screws in screw holes prior to assembly/fastening. (Curran Declaration, para. 4).

Therefore, on the basis of the "secondary consideration" of long-felt but unsolved need, the rejection for obviousness is invalid.

II. CONCLUSION

On the basis of the foregoing, it is respectfully submitted that the claims as amended patentably distinguish over the cited art, that the rejection thereof should be reconsidered and withdrawn, and that all claims should be allowed.



Respectfully submitted,
EVANNS & WALSH

Joseph R. Evanns
Registration No. 25, 676
Attorney for Applicant

Dated: 11/30/2007

Joseph R. Evanns
EVANNS & WALSH
119 North San Vicente Blvd., Ste. 206
Beverly Hills, CA 90211
Tel: (310) 273-0938, Fax: (323) 651-3027
Email: jrevanns@yahoo.com